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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/805,575
Filing Date: March 14, 2001
Appellant(s): VASSMER ET AL.

Charles F. Wieland III
<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/27/06 appealing from the Office action

mailed 6/27/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial

proceedings which will directly affect or be directly affected by or have a bearing on the

Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection

contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is

substantially correct. The changes are as follows: Claims 1 – 15 currently stand

rejected under 35 USC 103(a) as being unpatentable over Jammes et al. (US 6484149

B1) and further in view of Maynard (US 6484166 B1).

NEW GROUND(S) OF REJECTION

Claims 1 – 15 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| 6,484,149 | JAMMES ET AL. | 11-2002 |
| 6,484,166 | MAYNARD | 11-2002 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 – 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Jammes et al. (US 6484149 B1) and further in view of Maynard (US 6484166 B1).

Regarding independent claim 13,

Jammes et al. teach that *Then, in a step 506, the Initial_Event_Handler*

formulates a query 312 designed to retrieve data representing all groups and products

contained in (i.e., subordinate to) the root level group My Store 320 (Column 16, lines

58 – 61), compare with **a) presenting an initial set of descriptor tags using an**

output device. It should be noted that the Office has interpreted the *products* of

Jammes et al. to be synonymous with the claimed **descriptor tags**, i.e. 3.360 and 3.362

of Figure 3 of Jammes et al.

Jammes et al. teach that *In a step 532 (FIG. 5), the right pane 309 of the store design user interface 310 is displayed by a refresh method of the store management control 306. The refresh method of the store management control 306 displays information about products subordinate to a current group (i.e., a group represented by an icon in the left pane 308 that is selected by a user) and also displays information about groups subordinate to the current group* (Column 26, line 66 – Column 27, line 6), and that *The Get_Subordinate_Groups routine returns, in one embodiment of the present invention, a pointer to a linked list of group structures. Each group structure in the linked list contains information about a group, including Group_ID value and Group_Name value, and also includes a pointer to another group structure. The refresh method of the store management control receives the pointer to this linked list of structures and sequentially navigates the group structures. Navigation of the linked list terminates when a pointer of a group structure is null* (Column 27, line 63 – Column 28, line 5), compare with **b) receiving an instruction to assemble a new set of descriptor tags, the instruction being generated by a user using an input device to select a structure tag, the instruction resulting in the generation of a new set of information units, where the structure tag of the information units in the new set are interconnected to the information units of a previous set; and c) presenting the descriptor tags of the new set of the information units using the output device.** It should be noted that the Office has interpreted the *group(s)* of Jammes et al. to be synonymous with the claimed **structure tag**, i.e. 4.404 and 4.402 of Figure 4 of Jammes et al. It should also be noted that the Office has interpreted the *products* of

Jammes et al. to be synonymous with the claimed **descriptor tags of the new set of the information units**, i.e. 4.412 of Figure 4 of Jammes et al.

Jammes et al. teach that *In a further step 1614, a user repeats any of the steps 1602-1612 as needed to specify the inventory of an electronic store and to organize its presentation* (Column 45, lines 3 – 6), compare with **d) selectively repeating steps b) and c) at the user's request.**

Jammes et al. do not explicitly teach **b) receiving an instruction to assemble a new set of descriptor tags, the instruction being generated by a user using an input device to select a *solution category tag*, the instruction resulting in the generation of a new set of information units, where the *solution category tag* of the information units in the new set are interconnected to the information units of a previous set.**

However, Maynard teaches that *a method for retrieving and displaying information from at least one informational resource comprising the steps of: breaking apart the at least one informational resource into a plurality of discrete finite elements; creating a categorical tag for each of the plurality of discrete finite elements, the categorical tag including a categorical designation pertaining to informational content contained in the discrete finite element; generating a searchable database including a searchable database record for each of the discrete finite elements; receiving a search query; searching the searchable database for relevant database records that correspond to the search query; associating the relevant database records with their respective discrete finite elements; displaying identifying phrases pertaining to the*

respective discrete finite elements of the relevant database records produced during the associating step; receiving an input selecting one of the displayed identifying phrases; reconstructing a contiguous portion of the informational resource around the selected discrete finite element by combining other discrete finite elements with the selected discrete finite element; and displaying said reconstructed contiguous portion (Column 23, line 33 – Column 24, line 12), compare with **b) receiving an instruction to assemble a new set of descriptor tags, the instruction being generated by a user using an input device to select one of a structure tag and a solution category tag, the instruction resulting in the generation of a new set of information units, where at least one of the structure and the solution category tags of the information units in the new set are interconnected to the information units of a previous set.**

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Jammes et al. with that of Maynard because such a combination would allow the users of Jammes et al. the benefit of *an information management, retrieval and display system for searching through an informational resource, such as a document (e.g., a treaty), a number of individual documents (e.g., Web pages resident on the Internet), or a stream of information (e.g., DNA code, source code, satellite data transmissions, etc.) and for displaying the results of the search in an collapsible/expandable format based upon a user-selected display criteria or hierarchy* (Column 1, lines 48 – 56); in other words, a search based on categories of data.

Regarding independent claim 12,

Jammes et al. teach that *the HTML authoring tool produces a template file (i.e., a simple ASCII text file), representing a template page. Each such template file includes HTML formatting codes (or tags), text content, and references to the product information database 116 which can be resolved to extract information about a group or product* (Column 42, lines 21 – 26), compare with **an information item including information related to products; a descriptor tag indicating informational contents of said information item; and a structure tag pointing to at least one information unit in said data structure**. It should be noted that the Office has interpreted the *product ID* of Jammes et al. to be synonymous with the claimed **information related to products**, i.e. 3.360 of Fig 3 of Jammes et al.; the *group(s)* of Jammes et al. to be synonymous with the claimed **structure tag**, i.e. 4.404 of Fig 4 of Jammes et al.; and the *products* of Jammes et al. to be synonymous with the claimed **descriptor tag**, i.e. 4.412 of Fig 4.

Jammes et al. teach that *The Get_Subordinate_Groups routine returns, in one embodiment of the present invention, a pointer to a linked list of group structures. Each group structure in the linked list contains information about a group, including Group_ID value and Group_Name value, and also includes a pointer to another group structure. The refresh method of the store management control receives the pointer to this linked list of structures and sequentially navigates the group structures. Navigation of the linked list terminates when a pointer of a group structure is null* (Column 27, line 63 – Column 28, line 5), compare with **pointers interconnecting the information item, the descriptor tag, and the structure tag to an information unit**.

Jammes et al. do not explicitly teach **a solution category tag pointing to at least one information unit in the data structure;** and **pointers interconnecting the information item, the descriptor tag, _the solution category tag_ and the structure tag to an information unit.**

Maynard teaches that _the break module also creates categorical tags for each of these finite elements, where the categorical tags assigned to each of the finite elements are based upon and analysis (defined by the set of expert system rules) of the contents of each of the finite elements. The categorical tag can include a standard classification such as, for example, "Dewey Decimal-type" number. The categorical tag can also include an organizational attribute (such as pertaining to the type or location of the finite element with respect to the rest of the rest of the informational resource), a date-stamp, a categorical word, etc. Preferably, the categorical tags are inserted into the finite element_ (Column 1, line 67 – Column 2, line 11) and that _each database record preferably includes an address or pointer to the corresponding finite element and further preferably includes all of the non-common strings (e.g., words or phrases) contained within the corresponding finite element along with the frequency that such strings appear_ (Column 4, lines 54 – 58), compare with **a solution category tag pointing to at least one information unit in the data structure indicating membership of the information unit to a particular group;** and **pointers interconnecting the information item, the descriptor tag, the solution category tag and the structure tag to an information unit.** It should be noted that the Office has interpreted the _categorical tags_ of Maynard to be synonymous with the claimed **solution category tag.**

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Jammes et al. with that of Maynard because such a combination would allow the users of Jammes et al. the benefit of *an information management, retrieval and display system for searching through an informational resource, such as a document (e.g., a treaty), a number of individual documents (e.g., Web pages resident on the Internet), or a stream of information (e.g., DNA code, source code, satellite data transmissions, etc.) and for displaying the results of the search in an collapsible/expandable format based upon a user-selected display criteria or hierarchy* (Column 1, lines 48 – 56); in other words, a search based on categories of data.

Neither Jammes et al. nor Maynard explicitly teach **an information item including information related to *bearings* and *seals* or a solution category tag indicating membership of the information unit to *design*, *reliability*, *maintenance* and *training* categories.**

However these differences are only found in the nonfunctional descriptive material and do not affect the use and structural organization of the recited data structure. The use of "information items" including information relating to *particular* products, e.g. bearings and seals, and a solution category tag that includes pointers indicating membership of the information unit to a *particular* category, e.g. design, reliability, maintenance, and training, would be performed the same regardless of the particular products or categories. Similarly, the *particular* types of content within the recited data structure have no effect on the structural organization of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in

terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404

(Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to **indicate membership of the information unit to any**

type of category and to have **an information item including information related to**

any type of data or product, because such data does not functionally relate to the

steps in the claim and because the subjective interpretation of the data does not

patentably distinguish the claimed invention.

Regarding independent claim 1, the claim incorporates substantially similar

subject matter as claims 12 and 13, and is rejected along the same rationale. It should

be noted that all of the "limitations" recited in the preamble of claim 1 are recited in the

body of claim 12 and that all of the limitations recited in the body of claim 1 are recited

in the body of claim 13.

Regarding dependent claim 2, Jammes et al. teach that *FIG. 13 illustrates*

fields and command buttons of a new group dialogue box 1301 which prompts a user

for information about a new group. The new group dialogue box 1301 includes a

merchant ID field 1302, a Group_ID field 1304, a Group_Name field 1306, a template

file field 1308, a description field 1310, and a small image field 1312. Also included in

the new group dialogue box 1301 are a `Cancel` button 1314 and an `Okay` button

1316 (Column 38, lines 10 – 17), compare with **the descriptor tag of an information**

unit is constituted by a portion of its information item, and **the descriptor tag of**

an information item is constituted by a description of the contents of the information item.

Regarding dependent claims 14 and 15, the claims incorporate substantially similar subject matter as claims 12 and 13, and are rejected along the same rationale.

Regarding dependent claim 4, Jammes at al. teach that *in a preferred embodiment, each product included in the right pane display is represented by one row of text elements and each group included in the right pane display is represented by one row comprising an icon and a text label* (Column 28, lines 20 – 23), compare with **the information item is comprised by at least one of the following information types: text, photo, table and drawing.**

Regarding dependent claims 5 and 6, Jammes et al. teach that *if, in the step 2014, the Web server determines that the consumer did not order a product, then, in a next step 2018, the Web server 106 generates a database command designed to add a new record to the browse table of the traffic analysis database. It will be understood that such a database command accepts parameters representing values for the fields of a new record of the browse table. To supply a value for the Consumer_ID field of the new record, the Web server 106 access the consumer's cookie identifier and extracts the unique Consumer_ID value. The Web server establishes a value for the Template_File field of the new record by extracting a template file name from the URL of the request message* (Column 51, lines 40 – 52), compare with **the initial set of descriptor tags is based on a cookie from a previous use session of the computer**

program product, and that **the initial set of descriptor tags is based on a default set** (*template file(s)*).

Regarding dependent claims 7 – 11, Jammes et al. teach that *data records of a product information database store information comprising an inventory of an electronic store, including information about products and groups and the relationships between them* (Column 4, lines 22 – 25); that *the enhanced Web browser 112 initiates data transactions with the product information database 116. The enhanced Web browser 112 issues database transaction commands to the Web server 106, which in turn issues those transaction commands to a relational database server 114. In a preferred embodiment, the relational database server 114 utilizes open database connectivity (ODBC). Relational database servers 114 utilizing ODBC are known in the art. One function of such relational database servers is to provide to application programs a common query interface to interact with multiple database systems having different query interfaces* (Column 8, lines 46 – 57); and that *a web browser may be implemented as a collection of instructions stored on computer storage media (e.g., disk drive media, CD-ROM, ROM, EPROM, etc.), the instructions executable by a computer as an application program, as part of the operating system, as a dedicated function of network computer, or a combination of these or other forms for loading and executing instructions* (Column 6, lines 58 – 65), compare with **the information unit database is comprised in the computer program product**, that **the information unlit structure database is comprised in the computer program product**, that **the information unit**

database is integrated with the information unit structure database, that **intended**

to be used by a server connected to the Internet, and that **loaded on a carrier**.

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 15 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

Claim 12 has no practical application because there is no physical transformation

and no production of a useful, concrete, and tangible result. The definition of "data

structure" from the 5th edition of the IEEE Standard Dictionary of Electrical and

Electronics terms is "a physical or logical relationship among data elements, designed

to support specific data manipulation functions." It should be noted that mere use of the

term "data structure" does not mean a data structure is being claimed. In this case, the

elements of the data structure, when taken as a whole, constitute a mere compilation of

data and is thus non-statutory. Consequently, claim 12 recites nonfunctional descriptive

material per se because the data elements do not impart any functionality to the

computer. Descriptive material, such as mere arrangements or compilations of facts or

data, without any functional interrelationship is not a process, machine, manufacture or

composition of matter (Interim Guidelines for Examination of Patent Applications for

Patent Subject Matter Eligibility, Annex IV, pp 54 & 55).

Claims 1 – 11 and 13 – 15 do not produce a useful or tangible result. To be tangible the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. For example, merely assembling a new set of preexisting tags for presentation without creating anything new, i.e. rearranging data or narrowing the amount of data to be presented has been interpreted as just a thought or a computation within a processor and, thus, not tangible.

\For an invention to be "useful" it must satisfy the utility requirement of 35 USC 101. The Office's official interpretation of the utility requirement provides that the utility of a claimed invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP 2107. Further, the disclosure may have met the requirements for utility, but what's claimed does not produce a result that reflects it or is too preliminary in and of itself to be a useful result. Even though an appropriate utility has been disclosed, the claims fall short of the disclosed practical utility. In other words, the claims fail to fulfill and/or reflect the specific, substantial, and credible utility sought by the disclosed invention, thus not producing a useful result. Consequently, the claims are nonstatutory.

(10) Response to Argument

Appellant's arguments filed 2/27/06 have been fully considered but they are not persuasive.

Claims 1 – 11 and 13 – 15

The combination of Jammes et al. and Maynard does not disclose all of the claimed features.

In response to Appellant's arguments that claim 1 incorporates several limitations
that do not appear in claims 12 and 13 (p 4, second paragraph), it should be noted that
all of the "limitations" recited in the preamble of claim 1 are recited in the body of claim
12 and that all of the limitations recited in the body of claim 1 are recited in the body of
claim 13.

In response to Appellant's argument that Jammes et al. is not directed towards
bearings and seals (p 4, last paragraph), it should be noted that although neither
Jammes et al. nor Maynard explicitly teach **an information item including information
related to one of bearings and seals**, this difference is only found in the nonfunctional
descriptive material and is not functionally involved in the step recited. Processing
"information items" would be performed the same regardless of the data. Thus, this
descriptive material will not distinguish the claimed invention from the prior art in terms
of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir.
1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, the Office contends that no patentable weight is given to the
descriptive material, i.e. to have **an information item including information related to
any type of data or product**, because such data does not functionally relate to the step
in the claim and because the subjective interpretation of the data does not patentably
distinguish the claimed invention.

In response to Appellant's argument that Jammes et al. do not teach limitations b
and d (p 5, second paragraph), it should be noted that Jammes et al. do teach **b)
receiving an instruction to assemble a new set of descriptor tags, the instruction**

being generated by a user using an input device to select one of a structure tag

and a solution category tag, the instruction resulting in the generation of a new

set of information units, where at least one of the structure and the solution tag of

the information units in the new set are interconnected to the information units of

a previous set, since the phrases select one of and at least one of constitute open

ended language requiring only one of a group. As explained in the rejection above,

Jammes et al. teach a structure tag (Figure 4.402) and thus also teach limitation d),

since Jammes et al. teach that *In a further step 1614, a user repeats any of the steps*

1602-1612 as needed to specify the inventory of an electronic store and to organize its

presentation (Column 45, lines 3 – 6), compare with d) selectively repeating steps b)

and c) at the user's request.

Furthermore, the Office chooses to address solution category tags in the

alternative to further expedite prosecution. The Office maintains that Jammes et al. do

not explicitly teach solution category tags. However, as explained in the rejection

above Maynard does teach solution category tags. It should be noted that the Office

has interpreted the *categorical tags* of Maynard to be synonymous with the claimed

solution category tag.

In response to Appellant's argument that Maynard does not remedy the

deficiencies of Jammes et al. regarding solution category tags (p 5, last paragraph), it

should be noted that although neither Jammes et al. nor Maynard explicitly teach

indicating membership of the information unit to one of design, reliability,

maintenance and training categories, this difference is only found in the

nonfunctional descriptive material and is not functionally involved in the step recited.

The use of a solution category tag would be performed the same regardless of the data.

Thus, this descriptive material will not distinguish the claimed invention from the prior art

in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404

(Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). .

Therefore, the Office contends that no patentable weight is given to the

descriptive material, i.e. to **indicate membership of the information unit to any type**

of category, because such data does not functionally relate to the steps in the claim

and because the subjective interpretation of the data does not patentably distinguish the

claimed invention.

In response to Appellant's argument that the combination of Jammes et al. and

Maynard does not teach **b) receiving an instruction to assemble a new set of**

descriptor tags, the instruction being generated by a user using an input device

to select a solution category tag, the instruction resulting in the generation of a

new set of information units, where the solution category tag of the information

units in the new set are interconnected to the information units of a previous set,

(pp 6 – 8), it should be noted that the Office maintains that Maynard generates

categorical tags for use with the invention of Jammes et al.

By Appellant's own admission,

> *the Maynard patent describes a system including a break module that*
>
> *parses through an information resource such as a document, a group of*
>
> *documents or a stream of information to create a number of "finite elements,"*

such as paragraphs, sections, sub-sections, and segments. Th. e break module

also creates and assigns categorical tags for each of the finite elements based

on a set of expert rules. Next, Maynard describes an "index module" that parses

through the finite elements identified/created/ processed by the break module to

create a searchable database of records, each record corresponding to one of

the finite elements. Each of these records includes an address or location of the

corresponding finite element, the categorical tag assigned to the finite element,

and a string contained in the finite element and its frequency within the finite

element (p 6, lines 9 – 20).

The Office maintains that the combination of Jammes et al. and Maynard would

be used by the skilled artisan at the time of the invention to meet the claim limitation of

b. The teachings of Maynard, e.g. generating categorical tags, combined with the

teachings of Jammes et al., e.g. creating a new group as depicted in Figure 13 and

selecting among those groups to display a new set of assembled items as depicted in

Figure 4.

No suggestion or motivation to combine Maynard with Jammes et al.

In response to appellant's argument that there is no suggestion to combine the

references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation came form the references themselves in that Jammes et al. teach that

> *Using the Merchant Workbench, the store designer uses a graphical user interface to <u>create and edit product information, establish categories of products, and organize a navigable hierarchy of products and categories</u>. The Merchant Workbench allows a merchant having little or no knowledge of HTML coding or database queries to design an electronic store wherein a collection of template <u>Web pages</u> is integrated with a product information database (or inventory control system) such that information is extracted on-demand from the database, merged with the <u>Web page</u> templates, and presented to consumers (Column 3, lines 2 – 12).*

Maynard teaches

> *an information management, retrieval and display system for searching through an informational resource, such as a document (e.g., a treaty), a number of individual documents (e.g., <u>Web pages resident on the Internet</u>), or a stream of information (e.g., DNA code, source code, satellite data transmissions, etc.) and for displaying the results of the search in an collapsible/expandable format based upon a user-selected display criteria or hierarchy (Column 1, lines 48 – 56).*

The Office maintains that one of ordinary skill in the art at the time of the

invention would have combined the teachings of Jammes et al. with that of Maynard

based at least in part for Web page processing.

Claim 12

The combination of Jammes et al. and Maynard does not disclose all of

the claimed features.

In response to appellant's argument that neither Jammes et al. nor Maynard

disclose all the claimed elements of claim 12 (pp 9 & 10), it should be noted that the

Office has interpreted the *product ID* of Jammes et al. to be synonymous with the

claimed **information related to products**, i.e. 3.360 of Fig 3 of Jammes et al.; the

group(s) of Jammes et al. to be synonymous with the claimed **structure tag**, i.e. 4.404

of Fig 4 of Jammes et al.; and the *products* of Jammes et al. to be synonymous with the

claimed **descriptor tag**, i.e. 4.412 of Fig 4.

The Office maintains that neither Jammes et al. nor Maynard explicitly teach **an**

information item including information related to *bearings* and *seals* or a solution

category tag indicating membership of the information unit to *design*, *reliability*,

***maintenance* and *training* categories.**

However these differences are only found in the nonfunctional descriptive

material and do not affect the use and structural organization of the recited data

structure. The use of "information items" including information relating to *particular*

products, e.g. bearings and seals, and a solution category tag that includes pointers

indicating membership of the information unit to a *particular* category, e.g. design,

reliability, maintenance, and training, would be performed the same regardless of the

particular products or categories. Similarly, the *particular* types of content within the

recited data structure have no effect on the structural organization of the data. Thus,

this descriptive material will not distinguish the claimed invention from the prior art in

terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404

(Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to **indicate membership of the information unit to any**

type of category and to have **an information item including information related to**

any type of data or product, because such data does not functionally relate to the

steps in the claim and because the subjective interpretation of the data does not

patentably distinguish the claimed invention.

No suggestion or motivation to combine Maynard with Jammes et al.

In response to appellant's argument that there is no suggestion to combine the

references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation

came form the references themselves in that Jammes et al. teach that

> *Using the Merchant Workbench, the store designer uses a graphical user*
>
> *interface to <u>create and edit product information, establish categories of products,</u>*
>
> *<u>and organize a navigable hierarchy of products and categories</u>. The Merchant*
>
> *Workbench allows a merchant having little or no knowledge of HTML coding or*
>
> *database queries to design an electronic store wherein a collection of template*
>
> *<u>Web pages</u> is integrated with a product information database (or inventory*
>
> *control system) such that information is extracted on-demand from the database,*
>
> *merged with the <u>Web page</u> templates, and presented to consumers (Column 3,*
>
> *lines 2 – 12).*

Maynard teaches

> *an information management, retrieval and display system for searching*
>
> *through an informational resource, such as a document (e.g., a treaty), a number*
>
> *of individual documents (e.g., <u>Web pages resident on the Internet</u>), or a stream of*
>
> *information (e.g., DNA code, source code, satellite data transmissions, etc.) and*
>
> *for displaying the results of the search in an collapsible/expandable format based*
>
> *upon a user-selected display criteria or hierarchy (Column 1, lines 48 – 56).*

The Office maintains that one of ordinary skill in the art at the time of the

invention would have combined the teachings of Jammes et al. with that of Maynard

based at least in part for Web page processing.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)**

above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer

exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal**

as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the

primary examiner by filing a reply under 37 CFR 1.111 with or without amendment,

affidavit or other evidence. Any amendment, affidavit or other evidence must be

relevant to the new grounds of rejection. A request that complies with 37 CFR

41.39(b)(1) will be entered and considered. Any request that prosecution be reopened

will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Nathan Hillery

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:
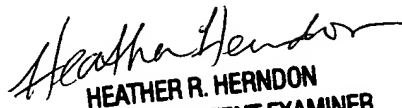
HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Paul Sewell, 2100 Director

Conferees:

HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Heather Herndon, Supervisory Examiner, GAU 2176

STEPHEN HONG
SUPERVISORY PATENT EXAMINER

Stephen Hong, Supervisory Examiner, GAU 2178

Doug Hutton, Primary Examiner, GAU 2176